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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,872	06/02/2004	Otis L. Nelson JR.	200406PM	3871

23688 7590 12/31/2007

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EXAMINER	
TOOMER, CEPHIA D	

ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
12/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/709,872	NELSON ET AL.	
	Examiner	Art Unit	
	Cephia D. Toomer	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed October 3, 2007 in which claims 3-7 were amended and claim 2 was canceled.

The obviousness double patenting rejection is withdrawn in view of Applicant's statement.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendment canceling claim 2.

It is noted that under the Remarks/Arguments section Applicant states that claims 1-7 remain (claim 2 has been canceled), claim 1 was not amended, there is no new claim 22 and the application does not nor has ever contained claims 9-12 and 14-21. The examiner is assuming that remarks were inadvertently added .

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson ('723).

Nelson ('723) discloses a motor fuel additive composition comprising a mixture of (a) from about 5 to about 50 percent of a detergent component, wherein the detergent component is the same as that of instant claim 1, and (b) a fuel conditioner component comprising (i) from about 2 to about 50 percent of a polar oxygenated hydrocarbon, having an average molecular weight, acid number, and saponification number the same as that of instant claim 1, and (ii) from about 2 to about 50 percent of an oxygenated compatibilizing agent, wherein the solubility parameter and hydrogen-bonding capacity is the same as that of instant claim 1 (col. 3, line 13-col. 4, line 15; claim 1). Further, preferred embodiments of the amino compound reactant of formula (II) are given in Table 2, such that Y = NR_5. The additive composition is added to a base fuel in amounts between 50 ppm and 2000 ppm (col. 10, lines 44-50; col. 11, lines 14-20).

Nelson ('723) does not disclose: (i) addition of the additive composition to a base fuel simultaneously, before, or after other additives, and (ii) specifically a diesel fuel additive composition.

With respect to (i) above, regarding claims 3-5, although Nelson ('723) does not disclose the addition of the additive composition to a base fuel simultaneously, before or after other additives, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the

product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe,* 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi,* 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed addition of the additive composition to a base fuel simultaneously, before or after other additives and given that Nelson ('723) meets the requirements of the claimed composition, Nelson ('723) clearly meets the requirements of present claims 3-5.

With respect to (ii) above, it is the examiner's position that although the additive composition is not directed specifically towards a diesel fuel, the disclosure of motor fuel encompasses diesel fuel, since diesel is a type of motor fuel. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to utilize the composition of Nelson ('723) as a diesel fuel additive composition because of the generic usage of the term motor fuel in Nelson ('723).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the fact that a class of additive compounds will provide benefit to a gasoline composition does not suggest that it will also provide the unexpected synergistic benefits in diesel fuel, or the timing of adding such a compound to the diesel fuel.

Nelson teaches that the fuel additive composition of his invention may be employed in a wide variety of hydrocarbon or modified hydrocarbon fuels. This teaching alone suggests what Applicant has done. There is nothing in Nelson to suggest that this teaching of a wide variety of hydrocarbon fuels does not include diesel fuel. Furthermore, Applicant's data have been reviewed and there are no unexpected results presented. Nelson teaches adding the fuel additives to fuels that may include diesel fuel. This is what Applicant has done.

With respect to Nelson not teaching reduction of particulate emissions, accelerated combustion, reduced ignition delay and increased Cetane number, Nelson teaches a similar fuel composition and one skilled in the art would have a reasonable expectation that by practicing Nelson the above properties would be obtained.

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

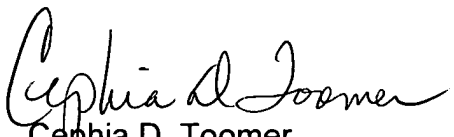
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cephia D. Toomer
Primary Examiner
Art Unit 1797

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